IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James J. Estrada   Art Unit   : 2128
Patent No. : 7,574,335   Examiner : Suzanne Lo
Issue Date : August 11, 2009   Conf. No. : 6004
Serial No. : 10/777,566
Filed   : February 11, 2004
Title   : MODELLING PIECE-WISE CONTINUOUS TRANSFER FUNCTIONS FOR
             DIGITAL IMAGE PROCESSING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 698 to 1112 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

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35 U.S.C. § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." "B delay" begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

A first PTO action was due on or before April 11, 2005 (the date that is fourteen months after February 11, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on April 9, 2007, thereby according a PTO Delay of 728 days. Patentee does not dispute the PTO's calculation for this "A Delay" from April 12, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to April 9, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before April 5, 2009 (the date that is four months after December 5, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on April 7, 2009, thereby according a PTO Delay of 2 days. Patentee does not dispute the PTO's calculation for this "A Delay" from April 6, 2009 (the day after the date that is four months after the date on which a response to Office Action was filed), to April 7, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 730 days.

"B Delay"

The period beginning on February 12, 2007 (the day after the date that is three years after February 11, 2004, the date on which the application was filed), and ending August 11, 2009 (the date the patent was issued), is 912 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on

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May 27, 2008, and the patent issued on August 11, 2009, resulting in a period of 441 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed.
See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 471 days (i.e., 912 days minus 441 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 471 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

April 12, 2005, to April 9, 2007; and

April 6, 2009, to April 7, 2009.

As detailed above, "B Delay" accumulated during the following period:

February 12, 2007, to May 27, 2008.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 57 days, from February 12, 2007, to April 9, 2007.

Applicant Delay

A reply to an Office Action was due on or before April 25, 2008 (the date that is three months after January 25, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on May 27, 2008, thereby according an Applicant Delay of 32 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from April 26, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to May 27, 2008. See 37 C.F.R. § 1.704(b).

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In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as <u>32 days</u>.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 698 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

1) Total PTO Delay should be calculated as 1144 days (i.e., the sum of 730 days of "A Delay" and 471 days of "B Delay" minus 57 days overlapping delay);

2) Total Applicant Delay should be calculated as 32 days; and

3) <u>Total PTA should be calculated as 1112 days</u>.

The fee of $200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0620001.

Respectfully submitted,

Date: October 6, 2009

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